



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,633	11/29/2001	Dennis Jones	38545-0014	3213

26633 7590 03/19/2002

HELLER EHRMAN WHITE & MCAULIFFE LLP
1666 K STREET,NW
SUITE 300
WASHINGTON, DC 20006

EXAMINER

WEDDINGTON, KEVIN E

ART UNIT PAPER NUMBER

1614

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/995,633

Applicant(s)
Jones

Examiner
Kevin E. Weddingt n

Art Unit
1614



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 15, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above, claim(s) 17-43 and 54-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 44-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 20) ☐ Other:

Art Unit: 1614

Claims 1-64 are presented for examination.

Applicant's preliminary amendment filed November 29, 2001 and the information disclosure statement filed February 15, 2002 have been received and entered.

Applicant's election filed February 13, 2002 in response to the restriction requirement of January 30, 2002 has been received and entered. The applicant elected the invention described in claims 1-16 and 44-53 (Group I) without traverse.

Claims 17-43 and 54-64 are withdrawn from consideration as being drawn to the non-elected invention. (37 CFR 1.142(b))

Claim Rejections - 35 U.S.C. § 112

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rendered vague and indefinite because the claim recites a weight reduction composition, but the so called weight reduction composition discloses only one component, a substance. A composition usually discloses two components and the applicant has not disclosed the second component. Claims 1-11 are rendered indefinite to the extent that they incorporate the above terminology.

Art Unit: 1614

Claim 12 is rendered vague and indefinite because the claim recites an improved composition of a material derived from Citrus species and varieties of plants to cause weight loss and control body weight, but the so called improved composition discloses only one component, said material. Again, a composition usually discloses two components and the applicant has not disclosed the second component. Claims 13-16 are rendered indefinite to the extent that they incorporate the above terminology.

Double Patenting

Claims 44-47, 52 and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,224,873. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application teaches a method for stimulating thermogenesis in human wherein the improvement comprises administering by mouth at least one substance, and the patented application teaches a method for stimulating thermogenesis in human by administering by mouth the same substance. Basically, the two inventions are doing the same utility and one skilled in the art would be able to fine an improvement to his own invention in the absence of evidence to the contrary.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29

Art Unit: 1614

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Orman*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44-47, 52 and 53 are not allowed.

Claims 48-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,340,482.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application teaches a method of treatment for fostering weight reduction with a weight reduction composition containing a plant material, and the patented application teaches a method for inducing weight loss with a substance from a plant material. Clearly the two inventions are basically the same, the use of plant material to reduce weight in human, and both inventions overlaps each other.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Orman*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 1614

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 48-51 are not allowed.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colker et al.(R) or Jones (S).

Colker et al. or Jones teaches the effects of *Citrus aurantium* extract on body fat loss and lipid levels of overweight (obese) healthy adults.

The instant invention differs from the cited references in that the cited references do not teach the substances, such as synephrine, hordenine, octopamine, tyramine and N-methyltyramine. However, the applicant states that the above substances are derived from


Art Unit: 1614

Citrus species and varieties of plants, and the *Citrus aurantium* is such a species. Clearly the applicant's instant compounds are disclosed and are taught to suppress body fat in humans.

The instant invention differs from the cited references in that the cited references do not teach applicant's specific amounts for the active compounds as disclosed in claims 2-6. However, to determine an amount having the optimum effect to reduce body weight is well within the level of one having ordinary skill in the art, and the artisan would have been motivated to determine optimum amounts to get the maximum effect of the claimed compounds and compositions.

Claims 1-16 are not allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner K. Weddington whose telephone number is (703) 308-1235.


Kevin E. Weddington
Primary Examiner
Art Unit 1614

K. Weddington

March 13, 2002